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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

24333 7590 06/24/2005

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EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,666	THOMAS, KEITH C.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19,22-25 and 33-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19, 22-25 and 33-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 3/28/2005.

2. Claims 19, 22-25, and 33-39 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 19-20, 22-39 and 55-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (5,946,664 hereinafter Ebisawa) in view of Margulis (5,946,664 hereinafter Margulis).

With respect to claims 19-39 and 55-65, Ebisawa teaches a removable moving media comprising: a source content (video game); a removable content disposed within the source content (col. 3, lines 58-60), a communication assembly in connection with a virtual product source providing access to the source content and the removable content (col. 3, lines 20-35, col. 5, lines 12-21, 30-35, col. 6, lines 10-20, 35-38, col. 6, line 50- col. 8, line 25)., wherein the communication assembly allows the visual product source to place a virtual product within the removable moving media through utilization of the removable content disposed within the source content (col. 3, lines 58-60). Ebisawa also teaches a method for placement of visual product in a moving media, comprising selecting an original source media including a removable content, the

removable content providing a visual product location (col. 3, lines 20-35, 01. 5, lines 12-20, 01. 7, lines 30-67),receiving a virtual product content from a peripheral visual product source (col. 7, lines 1-10, 30-67, col. 5, lines 12-20, col. 6, lines 12-19, lines 35-38)., editing the original source media and inserting the visual product content in the visual product location of the original source media (col. 3, lines 50-60, col. 7, lines 10-25). Ebisawa also teaches a system for placing virtual products within a moving media comprising an original moving media content source including a removable content, the removable content providing a visual product location (col. 3, lines 20-35),. a network in communication with the original moving media content source, the network providing a visual product source (figs, 7-9 and related text, col. 5, lines 12-20), a visual product disposed within the virtual product source, the visual product being enabled for placement in the virtual product location of the removable content (advertisements described; wherein the visual product is downloaded from the network and placed on the moving media in the virtual product location (col. 5, lines 12-20, lines 60-65, col. 3, lines 20-35, 55-60).

Ebisawa also teaches the visual product source is at least one of a network and a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text; the virtual product source updates the visual product location on the removable content within the source content (col. 5, lines 35-50)', the source content is a video game (col. 1, lines 15-20) wherein the source content is at least on of a streaming video or video stream and a video file format (col. 7, lines 12-20, 50-60), the source content is a digital source content (col. 5, line 60 - col. 6, line 20). In this case, a

virtual product refers to any object which is replaced or replaces in a scene for the purposes of providing advertising. To the extent that the claim to a visual product may be interpreted differently, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a virtual product in Ebisawa since product placement is well known in the art for product exposure and advertisement purposes and would have been adopted for the intended use of the artistic choices of the game manufacturer and sponsors). It also would have been obvious to have the virtual product placed within the moving media through a paint process since this would have been adopted for the intended use of providing static advertisements such as on the billboard of Ebisawa.

Ebisawa teaches the newly added feature of the communication assembly allows the virtual product source to update a position of the virtual product location within the removable moving media (i.e. product B location is updated from a non-display location to a display location, the same applies for product D)(Figures 1A-1B and 2A-2B).

Ebisawa substantially teaches the invention as described above, but does not show that the product is a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product or a can of beer. Margulis teaches replacement of objects including a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product (col. 16, line 59 - col. 17, line 5). It would have been obvious to

one having ordinary skill in the art at the time of the invention to have inserted/replaced an object in Ebisawa as in Margulis since the objects of Margulis are used as advertisements and would have been adopted for the intended use of updated advertising. It also would have been obvious to have the commercial item as a can of beer since this would have been adopted for the intended use of a beer manufacturer advertising campaign.

With respect to claim 66, in addition to the limitations addressed above it further teaches the source content adhering to an MPEG-4 format. Official notice is taken that is old and well known in the computer related files for files to adhere to a MPEG-4 format because such a modification would provide a much smaller format without sacrificing quality. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the source content adhering to an MPEG-4 format in order to obtain the above mentioned advantage.

Response to Arguments

4. The objection to the specification has been withdrawn.

5. Applicant argues that Ebisawa doesn't teach updating a position of the virtual product location. The Examiner respectfully disagree with Applicant because in Ebisawa the location of advertisement B and D are updated. In Figures 1A-1B, and Figures 2A-2B, In order for advertisements A and C to be replaced with advertisements B and D, the location of advertisements A and C has to be changed in order for

advertisements B and D to take it's place. Therefore advertisements B and D's location is updated or improved from a non-display location to a display location.

Point of contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
6/20/2005